

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of :) Confirmation No.: 9809
John E. Holland *et al.*)
Serial No.: 10/075,786) Art Unit: 2831
Filed: February 13, 2002) Examiner: William H. Mayo III
For: PROTECTIVE COVER) Docket No. 3781-022

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Commissioner for Patents
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REPLY BRIEF

Sir:

This Reply Brief is filed pursuant to 37 CFR 41.41, in response to the Examiner's Answer (the Answer) mailed on June 9, 2010. This Reply Brief addresses specific issues raised by the Examiner in the Answer.

A. Claims 1-3 and 8-9 are not unpatentable over U.S. Patent No. 5,300,337 to *Andrieu et al.* (*Andrieu*) in view of U.S. Patent No. 5,393,682 to *Holland et al.* (*Holland*), and U.S. Patent No. 5,965,223 *Andrews et al.* (*Andrews*), under 35 U.S.C § 103(a).

The Examiner's answer fails to consider all of the evidence on the record, the Examiner's underlying rational of obviousness is inadequate, and the Examiner's conclusion as to obviousness is incorrect and therefore must be reversed. The Examiner's Answer does not contest or rebut that a person of ordinary skill in the art would not combine the prior art in the manner claimed because the combination results in an inoperable device.

1. The Examiner's Answer Does Not Address or Rebut Applicants' Position that Only Hindsight Provides the Motivation to Combine the References.

The rational underpinning of the Examiner's conclusion that claim 1 is obvious lacks an articulation why all the evidence on record supports the Examiner's conclusion. After stating the MPEP procedure on page 16, that there must be some motivation to combine reference teachings, with all due respect, the Examiner proceeds to ignore this. For this reason, only hindsight, not evidence, can explain the motivation to combine *Andrieu*, *Holland*, and *Andrews*.

First, the Examiner has done what the Federal Circuit has clearly foreclosed. That is, he has not considered the claims and the prior art as a whole. In assessing the patentability of a claim, the claim as a whole must be considered. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Every limitation is relevant. The claimed cover protects lengths of material which must be continuously moved back and forth across abrasive surfaces and in addition, subjected to chemicals, moisture, and weather extremes. These claim limitations, among others, provide structurally significant context the Examiner simply ignores or overlooks, as neither *Andrieu* nor *Holland* are designed to provide such protection.

Second, in combining *Andrieu* and *Holland*, the Examiner has not evaluated the prior art in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *Anderson v. Pella Corp.*, 300 Fed. App. 893, at 898 (Fed. Cir. 2008) (teaching for or against combining and modifying prior art references should be considered). If the Examiner had considered *Andrieu* and *Holland*, he could not have reasonably concluded that a person of ordinary skill would combine *Andrieu* with *Holland* because of such combination destroying the purpose and function of *Andrieu*. Nor would there be any conclusion that *Andrews* cures the deficiencies this combination creates.

Tellingly, the Examiner disregards and fails to even address the following:

1. Only warp yarns 10 are disclosed as being polyester (Column 3, lines 8-12). These warp yarns obviously do not substantially make up the fabric (Column 3, line 60 through Column 4, line 9).

2. As to the substantial yarn portion, *Andrien* requires “bulky filament yarns” 13 of any material (polyester not mentioned) as the fill yarn in the fabric sleeve to obtain the reliable closure it seeks. Using ultra high molecular weight polyethylene (UHMWPE yarns) for “a reliable closure” would not make a closure at all. UHMWPE yarns are, as a person skilled in the art would know, untextured filaments that have no bulk or loops. How would the closure work if UHMWPE yarns were used as fill yarns 13 (or II as stated in Column 3, line 62), which form the loop part of the closure means required in *Andrien*? It would not – which is why the Examiner has not addressed it.

3. *Andrien*’s additional stated purpose is to obtain a low cost cover. Using *Holland* fabrics would multiply cost for no apparent advantage to *Andrien*’s stated purpose.

Andrien and *Holland*, when combined, create a cover that would destroy the reliable closure *Andrien* seeks, thereby making such a cover prohibitively expensive. The Examiner either agrees with this, or has not fully considered all evidence and thus cannot articulate any cogent reasoning why a person of ordinary skill would disregard these teachings.

Third, there still remains an unanswered question of why would a person of ordinary skill in art, being aware of *Andrien* and its teachings, look to *Holland*, which shows a non-bulky and more costly alternative? The Examiner’s analysis does not reconcile this. The conclusion that claim 1 is obvious is just that-a conclusion that is not supported by a “rational underpinning.” For example, the Answer asserts that “*Holland* teaches that such a fabric be [sic] made of commercially available Spectra® fibers and having the specific parameters, overcomes the disadvantages of polyester fabric covers...” While citing *In re Lesbian* 125 USPQ 416 277 F2d 193, the Examiner concludes that “Spectra ® is known” and also states that it is simply a matter of obvious design choice to “select a known material on the basis of its suitability for the intended use.” (Page 20 of the Answer.) But is it suitable for *Andrien*’s purpose? *Andrien* requires polyester yarns in the warp for the cover, and if one modifies *Andrien* to include UHMWPE yarns (from *Holland*) in the warp as the Examiner essentially asserts, the purpose of *Andrien* is destroyed and *Andrien*’s cover would be inoperable. Creating an inoperable device is not a matter of obvious design choice, because a design choice arguably should result in an operative device. A material, UHMWPE yarns, that works for its intended purpose should not destroy that which it is supposedly used to replace. There is no

evidence that using the UHMWPE yarns in the *Andrieu* cover would permit its closure as described and claimed therein- it could not function as described. Accordingly, the person of ordinary skill would not pursue the line of development as the Examiner asserts at pages 8, 9 and 10 of the Answer.

As described above, *In re Lesbin* is cited by the Examiner to support the combination of *Andrieu* and *Holland* as a matter of obvious design choice, but *In re Lesbin* is not on point. First, *In re Lesbin* concerns combinations of known elements. *In re Lesbin* at 199. The claims of this application require more than what the prior art of record teaches or suggests, thus *In re Lesbin* is off the mark. Further, the applicant in *In re Lesbin* stated on the record that the claimed “plastics were known” and were “selected for their intended purpose.” *In re Lesbin* at 198. Applicants have made no such acknowledgement in this application. In this regard, *In re Lesbin* is not applicable here. Further, it is noteworthy that the Federal Circuit, in *In re Lesbin* actually reversed the rejection of claim 18 under 35 U.S.C. 103(a) because the Examiner and the BPAI combined prior art references that destroyed the purpose of the primary reference. *In re Lesbin* at 200. This is exactly the same position as application takes here.

The Federal Circuit has recently considered what evidentiary basis and rational supports a conclusion that a patent claim is obvious and concluded that a clear articulation of the reasoning behind such a rational must be present in a form that is sufficient to warrant review. The Federal Circuit held in *Trimed v Stryker*, that where there is no clear articulation of why claims were obvious based on all evidence on the record, summary judgment of invalidity under 35 U.S.C. 103(a) is improper. The Federal circuit thus reversed summary judgment of invalidity under 35 U.S.C. 103(a), and the case was re-assigned to a different fact-finder. *Trimed v Stryker*, 2010 WL 2292312 (Fed. Cir. 2010) at 7¹. Here, as in *Trimed v Stryker*, the Examiner’s statement that claim 1 is obvious does not come with the clear reasoning required to support the conclusion. Because the Examiner states that claim 1 is obvious does not make it so, just as the Federal Circuit concluded in *Trimed v. Stryker*.

¹ The Federal Circuit decided *Trimed v. Stryker* on June 9, 2010, after the Applicants filed their Appeal Brief. This Federal Circuit decision is relevant to this appeal and its application to facts in this appeal is not a “new argument.”

The Federal Circuit in *Trimed v Stryker* stated that specific reasoning is required in any obvious analysis. In particular, “...on summary judgment, to invoke 'common sense' or any other basis for extrapolating from prior art to a conclusion of obviousness, a district court must articulate its reasoning with sufficient clarity for review.” (Emphasis added). Citing *In re Kahn*, 441 F.3d 977, 988 (Fed.Cir.2006) (there must be an articulated reasoning with some rational underpinning to support the legal conclusion of obviousness).

The Federal Circuit foreclosed Stryker's attempt to circumvent questions of fact, an attempt made by suggesting that a claim would have been obvious because it is a common sense solution to a known problem. Just as in *Trimed*, the Examiner has improperly extrapolated from the prior art what a person of ordinary skill might do with *Andrieu*, *Holland* and *Andrews* before him. The Examiner, however, has not articulated any reasoning to support the conclusion that a person of ordinary skill in the art would have been led to the combination. To the contrary, based on ALL of the evidence on the record—namely what *Andrieu*, *Holland* and *Andrews* disclose, the result of such combination would seem to be rendered inoperable. As the Federal Circuit aptly put in *Trimed v Stryker*, “merely saying an invention is a logical common sense solution to a known problem does not make it so.” Merely stating that *Andrieu*, *Holland* and *Andrews* make the claimed invention obvious does not make claim 1 obvious.

Finally, the Examiner states that “courts have long held that the fact that applicant has recognized another advantage which would flow naturally from the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).” (Page 17 of the Answer.) But the Examiner's application of this decision is only relevant to the extent that a person of ordinary skill will take the “suggestions” and naturally arrive at the claimed invention. As discussed above, the modification of *Andrieu* and *Holland* destroys the purpose of *Andrieu*. This not a natural progression. And the Examiner's analysis has not considered this issue at all. What Applicants have claimed is not the advantage that naturally flows from what is disclosed in *Holland*, or in what *Andrieu* contributes to the cover art for automobiles. Rather it is a protective cover for cables that are moved repeatedly and used in hostile environments, that have specific structural details that accomplish this purpose, all of which are not disclosed in the art.

The Examiner also states that *Andrieu* and *Holland* "fulfills the stated purpose of *Andrieu* (i.e. abrasion and weather resistant)." (Page 18 of the Answer.) This is not accurate. There is simply no recitation of being resistant to weather as a purpose of *Andrieu*. *Andrieu* only mentions "abrasion and heat" (Column 1, line 17). Here is what *Andrieu* states as objectives:

"In accordance with the foregoing, important objectives of the present invention include the following:

the provision of a wraparound sleeve with fastening means comprised of hook tape disposed to interengage with filaments or groups of filaments of interwoven bulky multifilament fill yarn exposed along a marginal edge of the sleeve material;

the provision of fastening means for a wraparound sleeve which eliminates the need for taping or ticing;

the provision of a fastening means for a wraparound sleeve which readily accommodates breakout with substantially no tendency of the jointed sleeve edges to separate; and

the provision of a fastening means for a wraparound sleeve which eliminates the need for a special tool for fastening the sleeve edges together.

A still further objective of the invention is the provision of a wraparound sleeve having fastening means which accommodates considerable variation in the overall size of the elongated article or articles being protected. (emphasis added) Col. 2 lines 29-51 of *Andrieu*

As can be seen in the above portions of *Andrieu*, none state that the objective is aimed at weather resistance or chemicals, or even moisture. They all concern aspects that only the specific type of closure that the *Andrieu* seeks could address.

2. The Examiners Answer is Inaccurate Regarding The Applicants' Position.

The Examiner's reliance on *In re Keller* and *In re Merck & Co* at page 16 of the Answer is misplaced. The Examiner cites these cases for the proposition that "one cannot show non-obviousness by attacking reference individually where the rejections are based on combinations of references." (Page 16 of the Answer.) However, the Federal Circuit is equally clear, as discussed above, that the claims and prior art as a whole must be considered. In this situation, Applicant has called attention to individual references to support the argument that the combination is improper.

In conclusion, the combination of *Andrieu*, *Holland* and *Andrews* destroys the purpose of *Andrieu*. A person of ordinary skill would surely consider this, and be dissuaded from such a combination. The only incentive on record to use UHMWPE yarns in a woven fabric with a film bonded thereto in a protective cover for cables, etc., was recognized by the Applicants, thus any motivation to combine could derive only from the application as filed, not from any other source as presented by the Examiner. At least for all of the reasons stated above, claim 1 is patentable over the cited art. Accordingly, the Applicants request the Board reverse the rejection of claim 1. Because claim 1 is patentable, claims dependent therefrom are also patentable.

B. Claims 27-29 and 34-35 are not unpatentable over U.S. Patent No. 5,300,337 to *Andrieu et al. (Andrieu)* in view of U.S. Patent No. 5,393,682 to *Holland et al. (Holland)*, and U.S. Patent No. 5,965,223 *Andrews et al. (Andrews)*, under 35 U.S.C § 103(a).

1. For the same reasons that claim 1 is patentable, so is claim 27 and the claims dependent therefrom.

C. Claims 10-12 and 36-38 are not unpatentable over *Andrieu* in view of *Holland*, in view of *Andrews* and U.S. Patent No. 4,891,256 *Kite III et al. (Kite III)*, under 35 U.S.C. §103(a)

1. For the same reasons that claims 1 and 27 are patentable, so are claims 10-12 and 36-38.

D. Claims 13 and 39 are not unpatentable under *Andrieu* in view of *Holland* in view of *Andrews*, and U.S. Patent No. 5,070,597 *Holt et al.*, under 35 U.S.C. §103(a)

1. For the same reasons that claims 1 and 27 are patentable, so are claims 13 and 39.

E. Claims 1 and 27 are not unpatentable under 35 U.S.C § 112, 2nd paragraph, as being indefinite for failing to point and particularly claim the invention.

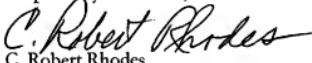
1. The Applicants amended the claims to address the rejection and remove the objectionable language in the Amendment filed January 7, 2010, and the Examiner entered the claim amendment on January 21, 2010. Applicants believe this ground of rejection has been addressed and there should be no 35 U.S.C § 112, 2nd paragraph issue with the claims. For this reason, this ground of rejection should be reversed. The Applicants believe the Examiner must have overlooked this.

CONCLUSION

For the foregoing reasons, the subject matter of the appealed claims would not have been obvious to one of ordinary skill in the art over the combination of references applied by the Examiner in the final rejection. It is therefore respectfully requested that the final rejection of claims 1-3, 8-13, 27-29 and 34-39 be reversed.

The Commissioner is hereby authorized to charge any fees that may be required for the timely consideration of this Reply Brief to Deposit Account No. 09-0528.

Respectfully submitted,



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